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| 09/502,542 | 02/10/2000 | Bruce L Davis | 60109 | 5321 |

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| EXAMINER | |
|---|---|
| FADOK, MARK A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3625 | |

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/502,542 | DAVIS ET AL. | |
| | Examiner | Art Unit | |
| | Mark Fadok | 3625 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *18 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,3-7 and 9-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-7 and 9-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 April 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/2/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

***Response to Amendment***

The examiner is in receipt of applicant's response to office action mailed 12/14/2004, which was received 4/18/2005. The examiner acknowledges the amended drawing and the change to the specification, both of which are entered. The drawing submittal has over come the drawing objection, however, applicant's arguments were not convincing in light of applicants submittal of IDS dated 6/2/2005, therefore the following new ground of rejection necessitated by IDS is provided below:

**Examiner's Note**

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Invention I***

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1,10,20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Swartz (US 6,243,447).**

1. (Original) A method comprising:

presenting a collection of retail items (col 7, line 41),

each having an indicia associated therewith, in a bricks and mortar store offering items for sale (FIG 3, item 75);

sensing the indicia associated with selected ones of said items (FIG 1);

compiling a list identifying the items whose indicia were sensed (FIG 4);

storing said list in a data structure associated with a user; and later recalling said list (FIG 4, item 124);

using said recalled list to present a customized selection of items in an on-line shopping environment (col 8, lines 7-53); and

receiving input from a user identifying a subset of items from said customized selection of items (col 3, lines 18-39).

10. (Previously Presented) The method of claim 1 in which the sensing comprises sensing said selected items along aisles at which said items are displayed, away from a checkout stand (col 3, lines 43-50).

20. (Previously Presented) A method of facilitating on-line shopping comprising: collecting data about products of interest during a shopper's visit to a bricks and mortar store,

said data being collected prior to check-out; and

using the data thereby acquired in a later on-line shopping session with said shopper (see response to claim 1).

21. (Previously Presented) The method of claim 20 wherein at least certain of the products of potential interest are not purchased by said shopper during said visit to said store (see response to claim 1).

22. (Previously Presented} The method of claim 20 wherein the data collection includes shopper activation of a shelf-based sensor associated with a product of interest (see response to claim 11).

23. (Previously Presented) The method of claim 20 wherein the data collection includes shopper use of a sensor device in the aisle of the store to collect data relating to a product of interest (see response to claim 10).

24. (Previously Presented) The method of claim 1 wherein at least one of said items is sensed while located in an aisle of the store, rather than at checkout (col 3, lines 43-50).

25. {Previously Presented) The method of claim 1 wherein the sensing of at least one item occurs without an associated purchase transaction (col 3, lines 17-38).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 11 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz in view of Official Notice.**

In regards to claim 11, Swartz teaches sensing a device but does not specifically mention that the device being sensed is and RFID device. It was old and well known in the art at the time of the invention to sense products using an RFID device. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Swartz sensing using RFID, because this would improve the capability of

Swartz' system by including additional capability sense products that may only have RFID devices.

In regards to claim 26, Swartz teaches reading barcode data from a product and storing the information in memory for later use and using the stored bar code data to create an order list which is distributed to a store for pricing and other information. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have the invention used for more than one store, since it has been held that mere duplication of the essential working parts of a system involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

***Invention II***

**Claims 3-6,1,14 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz in view of Official Notice.**

3. {Original) A method of conducting an online shopping session comprising:
identifying a user by reference to a login identifier (FIG 5);

recalling a list of products associated with the user (FIG 4);

presenting products from said list to the user for selection (FIG 4);

receiving user selections of products to be purchased (FIG 4);

receiving an indication that the user is finished selecting products (FIG 4); and

Swartz teaches creating a predicted shopping list that is generated from a customer's historical profile and providing promotional information related to a saved list of products scanned, but does not specifically mention that the user is alerted after the user finalized the transaction of an additional product they may have missed from the recalled list. Providing information about an apparent missed product such as something used in a recipe is old and well known in the art. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include providing additional information on products that may have been missed, because this would both increase sales revenue and provide a needed service to the busy customer who may have over looked that special ingredient. Swartz would be motivated to incorporate this information after all selections were made, because providing the information to early would be annoying since the person may be ready to select the products needed.

In regards to claim 12, Swartz teaches a recall list and providing the user with items not selected by the user, but does not specifically mention that the item is a cookie or dessert The examiner maintains that the list would be considered the set of items and the items upon the list the sub-set, therefore, understanding the opportunity for an infinite number of products in a store being placed on this list, the examiner has concluded that all items that could be present on a list are included as the sub-set to the total set of items being the list. Furthermore, the examiner does not understand the applicant's apparent differentiation between a dessert and a cookie, considering that one of ordinary skill in the art might consider a cookie (sub-set) within the definition of a

dessert item (total set or list), an example being a fortune cookie presented at the end of a Chinese meal as a dessert. Webster's dictionary defines dessert as a sweet course or dish served at the end of a meal. Considering this definition the examiner also points the applicant's attention to FIG 6, which has presented several sweet items such as hot cocoa and granola.

In regards to claims 5,6,13 and 14, Swartz teaches creating a predicted shopping list that is generated from a customer's historical profile and providing promotional information related to a saved list of products scanned, but does not specifically mention that the user is alerted of an additional product they may have missed from the recalled list. Providing information about an apparent missed product such as under the conditions stated in claims 5,6,13 and 14 is old and well known in the art. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include providing information on additional products that may have been missed, because this would both increase sales revenue and provide a needed service to the busy customer who may have over looked that special ingredient. Swartz would be motivated to incorporate this information after all selections were made, because providing the information to early would be annoying since the person may already be aware of the products needed.

In regards to claim 27, Swartz teaches reading barcode data from a product and storing the information in memory for later use and using the stored bar code data to

create an order list which is distributed to a store for pricing and other information. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have the invention used for more than one store, since it has been held that mere duplication of the essential working parts of a system involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

4. (Original) A computer storage medium having instructions thereon causing a computer to perform the process of claim 3 (see response to claim 3).

***Invention III***

**Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Swartz (US 6,243,447).**

7. (Original) A method comprising: logging a shopper's habits or preferences exhibited in an on-line shopping environment in one or more database records associated with that shopper (FIG 3); and

recalling said logged database record in a bricks and mortar store and using the logged information in connection with bricks and mortar shopping by said user (col 11, lines 20-25).

***Invention IV***

***Claim Rejections - 35 USC § 103***

**Claims 9,15-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (US 6,381,583) in view of Swartz.**

9. (Currently Amended) In a method of on-line shopping from a first vendor, an improvement comprising: displaying a virtual shopping aisle with graphical, rather than strictly textual -representations of items for sale (FIG 7),

wherein items of potential interest to a shopper are presented more prominently than other items (FIG 7, col 10, lines 1-5), and

Kenney teaches identifying items of potential interest by reference to the shopper's prior activity (FIG 7, reorder item), but does not specifically mention that the historical information was gathered at a brick and mortar store. Swartz teaches scanning data on a device, which can later be used to purchase products on-line (see response to claim 1). It would be obvious to a person of ordinary skill in the art at the time of the invention to include in Kenney using information gathered at a brick and mortar store as is taught by Swartz, because this would give Kenney the means for easily creating a personal shopping list from items available to the shopper (col 3, 30-35).

15. (Previously Presented) The method of claim 9 wherein said activity is activity in a bricks and mortar store associated with the first vendor (Swartz, FIG 3)).

16. (Previously Presented) The method of claim 9 wherein said activity is a shopping activity (FIG 10B).

17. {Currently Amended) In a method of on-line shopping from a first vendor, an improvement comprising displaying a virtual shopping aisle with graphical - rather than strictly textual -representations of items for sale (see response to claim 9),

wherein items of potential interest to a shopper are presented more prominently than other items (see response to claim 9), and

that includes identifying items of potential interest by reference to the shopper's prior activity in the a bricks and mortar store (see response to claim 9),

wherein said items of potential interest include at least one item that the shopper has not previously purchased from said first vendor (FIG 7, special today).

19. (Currently Amended) In a method of on-line shopping from a first vendor, an improvement comprising displaying a virtual shopping aisle with graphical - rather than strictly textual -representations of items for sale (see response to claim 9),

wherein items of potential interest to a shopper are presented more prominently than other items (see response to claim 9), and

that includes identifying items of potential interest, at least in part, by sensing identification data from products while at the shopper's residence (col 3, lines 20-35).

**Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kenney (US 6,381,583) in view of Swartz and further in view of Official Notice.**

18. (Currently Amended) In a method of on-line shopping from a first vendor, an improvement comprising displaying a virtual shopping aisle with graphical - rather than strictly textual-representations of items for sale (see response to claim 9),

wherein items of potential interest to a shopper are presented more prominently than other items (see response to claim 9), and

that includes identifying items of potential interest by reference to the shopper's prior shopping history (see response to claim 9),

Swartz teaches reading barcode data from a product and storing the information in memory for later use and using the stored bar code data to create an order list which is distributed to a store for pricing and other information. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have the invention used for more than one store, since it has been held that mere duplication of the essential working parts of a system involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

***Response to Arguments***

Applicant's arguments with respect to claim1,3-7,9-27 have been considered but are moot in view of the new ground(s) of rejection necessitated by an IDS received 6/2/2005.

***Conclusion***

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 6/2/2005 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(571) 272-6755**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(571) 272-7159**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **receptionist** whose telephone number is **(571) 272-3600.**

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

or faxed to:

**(571) 273-8300** [Official communications; including After Final communications labeled "Box AF"]

**(571) 273-6755** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Mark Fadok

Primary Examiner